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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/848,594 | 05/03/2001 | Sujal Bhalakia | 589.063US2 | 8703 |

37374 7590 06/21/2005

INSKEEP INTELLECTUAL PROPERTY GROUP, INC
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EXAMINER

ZACHARIA, RAMSEY E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1773

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,594

Applicant(s)

BHALAKIA ET AL.

Examiner

Ramsey Zacharia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-58 and 80-104 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 50-58 and 80-104 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

2. The specification is objected to because of the following informalities: graphic formula I on page 14 is missing.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. Claims 50-57, 80-95, and 97-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata et al. (U.S. Patent 5,702,813) in view of Kawaki et al. (U.S. Patent 5,051,309).

Murata et al. teach a composite molded lens comprising layers of treated (stretched or annealed) polycarbonate sandwiching a polarizing film with a layer of untreated polycarbonate injection-molded onto one of the treated polycarbonate layers (column 1, line 53-column 2, line 4). The polarizing film reads on the functional layer of instant claims 50 and 88 and the treated polycarbonate layers read on the first and second resinous layers. The total thickness of the treated polycarbonate layers is about 1.5 mm (column 2, lines 57-59). The polarizing film is bonded to each of the treated polycarbonate layers (column 2, lines 60-64). The lens may be

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used to form glasses for outdoor sports players that may be eyesight correcting, i.e. it may have a prescription power (column 1, lines 31-43).

Murata et al. do not disclose the composition of the polarizing film or how the polarizing film and the treated polycarbonate layers are bonded together.

Kawaki et al. teach a polarizing plate comprising a polarizing polymeric film that is disposed between polycarbonate plates (column 2, lines 22-29). The polycarbonate plates have been treated by stretching and heating (column 2, line 63-column 3, line 3). The polarizing film is bonded to the polycarbonate plates using an acrylic-type, epoxy-type, or urethane-type adhesive (column 3, lines 51-59). The polymeric film may be made of polyvinyl alcohol and have a thickness of about 20-120 μm (column 3, lines 24-29 and column 5, lines 51-56). The adhesives used by Kawaki et al. are taken to inherently have sufficient flexibility so as to substantially prevent crazing during injection molding, substantially prevent yellowing, and minimize shrinkage during cure since they appear to be the same adhesives used in the instant application (i.e. acrylic-type, epoxy-type, or urethane-type adhesives).

One skilled in the art would be motivated to use the polarizing film and adhesives of Kawaki et al. in the lens of Murata et al. because Kawaki et al. demonstrate that their polarizing film and adhesive are suitable for use between stretch and annealed polycarbonate plates. The selection of a known material based on its suitability for its intended use supports a *prima facie* determination of obviousness. See MPEP 2144.07.

Because the lens of Murata et al. is formed by injection molding the untreated polycarbonate layer onto the laminate comprising the treated polycarbonate layers and the

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polarizing film, the laminate will have edges that conform to the dimensions of the mold as required by claims 50, 80-82, 88, and 102-104.

Regarding claims 56 and 94, Murata et al. do not require the lens to be eyesight correcting, thus suggesting that the lens may be non-eyesight correcting. Furthermore, as a function of the lens is for outdoor sports players, it would be obvious to form the lens without any prescription power for players that do not require corrective glasses. Additionally with respect to claims 84-87 and 98-101, since Murata et al. teach the that lens may be eyesight correcting, it would be obvious to fashion the lens so as to satisfy any eyesight correction or prescription required by a particular user.

4. Claims 58 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata et al. (U.S. Patent 5,702,813) in view of Kawaki et al. (U.S. Patent 5,051,309), as applied to claims 50 and 88 above, and further in view of Guglielmetti et al. (U.S. Patent 5,631,720).

Murata et al. taken in view of Kawaki et al. teach all the limitations of claims 58 and 96, as outlined above, except for the use of a photochromatic layer as the functional layer.

Guglielmetti et al. teach a photochromic compound that may be incorporated into a polymer for use in sunglasses (column 6, lines 8-13). Polyvinyl alcohol is a suitable polymer to which the photochromic compound may be added (column 6, lines 14-20). The photochromic compounds are used to screen out light radiation according to its intensity (column 1, lines 20-25 and column 2, lines 19-37).

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One of ordinary skill in the art would be motivated to add the photochromic compound of Guglielmetti et al. to the polyvinyl alcohol layer of Kawaki et al. to yield sunglasses that are not only polarized but that also darken when exposed to intense light.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518.

The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ramsey Zacharia
Primary Examiner
Tech Center 1700